

REMARKS

In preparing this response to the Office Action, it was discovered that claim 29 was omitted and as a result, claims 30-46 were mis-numbered, i.e., they should have been numbered as claims 29-45. As a result, claims 30-46 have been amended to be claims 29-45.

In the Office Action, the Examiner rejected claims 1-5, 8, 10, 11, 13, 14, 16, 17 and 18 under 35 U.S.C. § 102(b) as being anticipated by Totten et al. (Patent No. 5, 716,910) and rejected claims 1, 7, 15, 33-36, 38, 40 and 42-45 under U.S.C. § 103(a) as being obvious over Totten et al. (Patent No. 5,716,910). In addition, the Examiner objected to claims 6, 9, 12, 37, 39 and 41 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Finally, the Examiner indicated that claims 19-32 are allowable over the art of record.

The patent to Totten et al. teaches a foamed drilling fluid which comprises a pre-hydrated clay, water, a foaming surfactant present in an amount sufficient to foam the drilling fluid, a stabilizing surfactant present in an amount sufficient to reduce break down of the foamed drilling fluid and a gas. In addition, the drilling fluid can include cement, a weighting material, a dispersing agent and other additives.

The foregoing is contrasted with the present invention which is not a foamed drilling fluid. Instead, the present invention is a foamed spacer fluid which is placed between two incompatible fluids to be contained or pumped within well bores. Examples of fluids between which the spacer fluid of this invention can be utilized include between hydraulic cement slurries and drilling fluids, between different drilling fluids during drilling fluid change outs and between drilling fluids and completion brines. In addition, the spacer fluids enhance drilling fluid and

filter cake removal from the walls of well bores, have displacement efficiency and physically separate chemically incompatible fluids.

While a number of the components utilized in the foamed spacer fluid of this invention are the same as or similar to the components in the foamable drilling fluids of Patent Number 5,716,910, the fluid compositions contain different combinations of components and are utilized for carrying out distinctly different operations. That is, Patent Number 5,716,910 discloses a foamable drilling fluid for use in well operations such as deep water off-shore drilling. The foamed spacer fluid of the present invention is utilized between incompatible fluids as described above.

In order to overcome the Examiner's rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a), and in view of the Examiner's indication that claims 6, 9, 12, 37, 39 and 41 would be allowable if rewritten in independent form, claims 1-5 have been canceled, claim 6 has been rewritten in independent form to include the limitations of claims 1-5, and claims 8-18 have been amended to depend from claim 6.

In a similar manner, claims 33-36 have been canceled, claim 37 has been amended to include the limitations of claims 33-36 and claims 38-45 have been amended to depend from claim 37.

It is respectfully submitted that claims 6-18 and 37-45 are not anticipated by Patent Number 5,716,910. "A claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference." Verdegaal Brothers v. Union Oil Company of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim" and all of the claim's elements must be "arranged as in the claim". Richardson v. Suzuki Motor Company, 868 F.2d

1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). Patent Number 5,716,910 to Totten et al. fails to satisfy these requirements.

It is also respectfully submitted that claims 6-18 and 37-45 are not obvious over Patent Number 5,716,910. In order to satisfy a prima facie case of obviousness, the prior art must contain some teaching, suggestion or incentive that would have motivated an artisan to modify the reference. See, In re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1958 (Fed. Cir. 1988). The prior art must teach or suggest all of the limitations of the claims without the slightest recourse to the teachings in the application. See, See, Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd., 927 F.2d 1200, 18 USPQ 2d 1016 (Fed. Cir. 1991). The proper test is whether “the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success.” In re Dow Chemical Co. vs. American Cyanamid Co., 837 F.2d 469, 473, 5 USPQ 2d 1529, 1531-32 (Fed. Cir. 1988). Patent Number 5,716,910 fails to satisfy these requirements.

It is submitted by the Applicants that claims 6-18 and 37-45 are now in condition for allowance in addition to claims 19-32 and such allowance is respectfully requested. This is intended to be a complete response to the Office Action mailed on September 21, 2004.

I hereby certify that this correspondence is being deposited in the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment; Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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